## REMARKS

Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,507,485 (Fisher) in view of US 5,319,548 (Germain) in further view of US 6,317,718 (Fano). This rejection is respectfully traversed.

Applicant, in the response filed 03/31/2003, admitted to confusion over the previous examiner's irregular characterization of rejections set forth in the Office Action to which the response was directed, and laboriously pointed out the issues in the purported statements of rejection. After doing so, it was stated "applicant assumes that examiner intended to restrict the rejection to section 103(a)," in which precisely the same references were applied in precisely the same way as they are in the current rejection. In the current Action, examiner first asserts (under the heading "Response to Arguments"), that "applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection." To which applicant respectfully asks: *What new grounds of rejection?* They are precisely the same grounds of rejection as those that applicant had expressly assumed the examiner intended to make, and that applicant argued at length in the response to the previous Action. Applicant's claims 1, 6 and 7 were amended in the previous response, but as is readily observed from a review of that amendment, not substantively and certainly not because of any teaching, suggestion, motivation or expectation contained in the references of record, whether considered singly or in any rational combination. Hence, applicant's previous arguments cannot be deemed "moot" (i.e., deprived of practical significance), and it appears to be quite clear, despite examiner's assertion, they have not been considered but instead, given short shrift.

The entire thrust of applicant's invention is to provide a golfer commencing to play a round of golf and who may consider doing so using an unfamiliar cart-based golf course navigation and information system, the opportunity to learn some of the basic advantages of such a system in playing the course by accepting a gratis trial period at the outset of play. Rather than being required to make the decision to bear the cost of the cart-based system "sight unseen" for a full round of play, or to forgo its use and be assigned a cart with system graphics or display rendered inactive, the golfer can try the system out at no cost for a few

holes, and then make a decision.

As stated at page 4 of applicant's specification, a principal objective of the present invention is to provide a method and apparatus which gives the player a reasonable but limited opportunity to evaluate such a system during play of the course, and to then make an informed decision by the time a specified point in play of the round is reached, of whether or not to continue using the system to complete the round. If the golfer finds the system to be to his or her liking, a commitment to payment for its use is made; otherwise no commitment of payment need be made and the system is automatically shut down with no fee incurred by the golfer for its earlier use and no other disablement of the cart.

Examiner acknowledges in the statement of rejection of applicant's claim 1, that "Fisher does not specifically teach invoking a gratis trial period ... during which the cart display of ... information is activated ..., and automatically rendering the cart display ... inactive at the end of the gratis trial period unless, by that point of play, a payment authorization has been made by a golfer using the cart." The error in that acknowledgment is that Fisher not only does not *specifically* teach invoking a gratis trial period -- Fisher doesn't teach applicant's method in even the most obtuse interpretation of that reference. Fisher doesn't suggest it, nor even hint at it. In short, Fisher is completely silent at the point of departure of applicant's invention *as disclosed and claimed.*

In a purported effort to overcome the glaring shortcomings of Fisher as a reference against applicant's claim 1, the examiner immediately turns to Germain, and asserts, notwithstanding the lack of a teaching or suggestion by Fisher: "However, the similar matter is taught by Germain as a golf course information system sets up account information for each golfer, each golfer is required to have sufficient payment or payment authorization for playing golf." That assertion, and the portion of Germain's specification cited in support of it, does not teach or suggest applicant's invention, alone or in combination with Fisher's specification. Neither reference suggests in any conceivable way, the limitations of "invoking a gratis trial period less than an entire round of play of the course during which the cart display of [the previously recited] information is activated for a golfer commencing use of the cart; and automatically rendering said cart display of such information inactive at the end of said gratis

trial period unless, by that point of play, a payment authorization for completion of the round with activated cart display has been made by a golfer using the cart" (claim 1). If examiner persists in this unfounded rejection, she is requested to point out specifically where either reference even hints at invoking a gratis trial period less than an entire round of play, or automatically rendering the cart's information display inactive at the end of a gratis trial period unless payment is then authorized for its continued use, so that applicant is fully informed of the grounds on which to base and argue an appeal.

Referring to Germain's specification, his Abstract briefly describes

> ...an interactive golf game information system that receives, stores, analyzes and outputs a plurality of different types of information related to golf. The system generates a golf play recording card for every hole on a golf course for a golfer to record information on his and companions' play of each hole, and for use to display information on how previous rounds of golf on the same course were played or to provide system recommendations concerning play. After the round is completed, the golfer-recorded cards may be inserted into the system for reading and processing the recorded information and compiling statistical information to analyze the golfer's performance.

Under the heading Field of the Invention, Germain states that his invention

> "relates to an interactive system for receiving, storing, analyzing and outputting information concerning the game of golf, and, more particularly, to an interactive golf information system that can read marks recorded on a golf play recording card and generate golf play statistics and analysis based on the marks that are read."

Under the heading Relevant Background, Germain briefly discusses the prior art, including a third party disclosure in which the data recorded on a scorecard provides information for a computer system to develop statistical information on a hole-by-hole basis or club-by-club basis for flight, distance, swing and positioning information, to be used by golfers to evaluate their play.

In his Summary of the invention, Germain states several objects of his invention, principally to provide an interactive golf information system for compiling and analyzing golf

play based on information recorded on a golf play recording card. In the same section, Germain summarizes his golf information system as:

> "... including a CPU with a user interface having a display device and an input device, that allows direct accessing of the system by the golfer in club house, or indirect accessing using a remote device. A user selection menu on the display allows the golfer to select a variety of system operating modes, including, if not ready to play, paying a transaction cost, reserving a tee time, generating a printed lesson based on previous rounds of golf played, printing or displaying a previously played round of golf, statistical analysis and information on a previous round or rounds of golf, league information, handicap, course conditions, information on other golfers and information on other golf courses; or, if ready to play, paying for the round of golf and use of the golf information system, customizing the recording cards and generating the cards, which are pocket-sized and provided for each hole. After the round is played, information recorded by the golfer on each card is input to the system as previously described, and the golfer selects any of various menu options on the display.

In the Detailed Description of operation of Germain's interactive golf game information system (referencing his flow chart of FIG. 6), which examiner cites as supporting her analysis and rejection, the specification states, in principal part:

> "If a golfer has not used the system before, account information and a data storage area must be set up ... [so] the system prompts the golfer to input personal information including name, address, [etc.], ... [and] also prompts the golfer to input a PIN number, ...[all of which is stored in] a storage information area ...for the golfer ..., [and then] the system will issue the golfer an identification card for automatic access to the system. The system will charge the new golfer's account for any set up costs and user's fees incurred in setting up the account. The golfer will have an opportunity to pay this amount and even add money to his identification/debit card if he so desires in the payment mode ....
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> "If the golfer has used the system before, the golfer only has to insert his identification card or enter his personal identification number to access the system. .... The ... golfer can select ...a payment mode ... (FIG. 7), [in which] the system first informs the golfer of the charges for setting up the account and use of the system, ... request the golfer to indicate the items for which payment is being made, ... including greens fees, system fees, club house meals, pro shop items and services such as caddies and lessons. ...The system will display each of the items and their costs along with a total cost ..., and inquire if the

golfer approves .... If the list is incorrect, the ... golfer [is allowed] to correct ...[it, and/or if] correct, ... the golfer [is prompted] to select a method of payment, ... including credit card, debit card, automatic bank teller machine card, cash, or bill it to a personal account.

* * * * *

"If ... cash [is used], ... the system will prompt the golfer to insert ...[it] into a conventional cash receiving device, ...[and] if sufficient cash is inserted, the transaction is completed, change is returned, and a receipt is printed....If [instead,] the user elects to bill the charges to a personal account, ... the system prompts the user to input an account identification in the form of a PIN number or a password...."

It should be abundantly clear from these passages, that Germain's disclosure is a far cry from "teaching similar matter" (examiner's words) to that of the method and apparatus disclosed and claimed by applicant. Similar in what respect? It is submitted that, in fact, Germain's system and method handles payment in a very conventional manner, automating only the manual actions of a human cashier, which is not in any way, shape or form Germain's invention. And again, where is any suggestion of a free trial period, or automatically rendering the cart-based information and display system inactive if payment is not authorized by the end of the trial period?

Examiner sidesteps these glaring deficiencies, while at the same time admitting that "Germain does not specifically teach providing a gratis trial period ,,, for the player" (or even generally, or deactivating the system thereafter absent payment), and asserts without benefit of one iota of support from the references themselves, that "it would have been obvious to one of ordinary [sic, skill?] in the art to allow the Germain [sic, system?] to provide a gratis trial period less than an entire round of play of the course for each golfer because it would attract more golfers to use the system." Examiner further asserts, again without benefit of any support from the references themselves: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the Fisher [sic, reference?] to include a gratis trial period for each golfer, and after the trial period, the golf [sic, golfer?] require [sic, be required?] to pay for using the system as taught by the modified method of Germain because it would attract more golfers to use this golf course system, and it would also [sic,

be?] easier for the owner of the golf course system to collect money from the golfers for using the system." With all due respect, this is "logic" that defies even the most fertile imagination. In addition to the fact that it would not lead to the method and system claimed by applicant, any attempt to combine Germain with Fisher would defeat the purpose of the Fisher system, by replacing Fisher's analytical techniques with a considerably more cumbersome recording card storage and retrieval system.

Section 103(a) of the patent statute refers to "obvious at the time the invention was made to a person having ordinary skill in the art," in the sense of the *Graham v. Deere* test imposed by the U.S. Supreme Court. Further, MPEP §706.02(j) states:

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. [Emphasis added].

For reasons amply stated above, it is submitted that none of these requirements for establishing a *prima facie* case of obviousness are present here. Even if there were any semblance of motivation to modify the references and to combine the references in the method or system proposed by examiner, it would not result in applicant's method or apparatus as disclosed and claimed. Furthermore, in her "ordinary skill in the art" argument, examiner completely ignores the fact that cart-based golf navigation and information systems of the general type described by applicant, without the aspect of method and apparatus for continuing play disclosed and claimed by applicant, have been in use on golf courses for several years before the filing date of the present application (for example, Fisher filed in April 1994 and Germain filed in April 1993). Yet no one prior to applicant has proposed or even suggested the method or apparatus claimed by applicant herein. If that were not the case, examiner surely could have found a reference or references to something considerably better than the ones she has attempted to kluge together here.

Fano adds nothing to the purported combination advanced by examiner, as a teaching or suggestion of the essence of applicant's invention as claimed.

The other main claims 6, 7, 10 and 11 stand rejected on the same grounds and reasoning applied by examiner against main claim 1, and the same arguments apply to those rejections. As to method claim 6, the references of record fail to teach or suggest a method that includes "establishing a gratis trial period less than an entire round of play of the course during which the cart display of [the previously recited] information is enabled for a golfer using the cart; and disabling said cart display of such information at the end of said gratis trial period unless, by that point of play, an act representing commitment of payment for completion of the round with enabled cart display has been detected." As to method claim 7, the same assertion applies to its limitations of "invoking a gratis trial period less than an entire round of play of the course during which the cart display of such information is activated for a golfer commencing use of the cart; and automatically maintaining said cart display of such information active for completion of the round if, by the end of said gratis trial period, a commitment of payment therefor has been made by a golfer using the cart."

Method claim 10 patentably defines over the reference of record in reciting "providing a gratis trial period for full availability of said information to the user on commencing use of the system, less than an entire round of play of the course, and automatically curtailing the amount of said information available to the user at the end of said trial period, unless payment authorization is given for continued full availability thereafter." And apparatus claim 11 does the same with respect to those references, in calling for "means adapted to implement a trial period for full availability of said information to the user on commencing use of the system, less than an entire round of play of the course, and means responsive to completion of said trial period without a commitment to pay for continued full availability of said information in further play of the round, for automatically curtailing the amount of said information available to the user from the system thereafter."

For the foregoing reasons, applicant submits that the section 103(a) rejections are clearly erroneous and should be withdrawn.

Reconsideration and withdrawal of the rejections, and allowance of this application,

are solicited.

Respectfully submitted,

KIRK BINGEMAN, ET AL.

Donald R. Greene
Registration No. 22470
P.O. Box 12995
Scottsdale, AZ 85267-2995
Telephone: 480-488-9895
Fax: 480-488-5654

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